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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,134	12/29/2000	Gary L. Shanklin	659/766	1798

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/753,134	SHANKLIN, GARY L.	
	Examiner	Art Unit	
	Lynda M Salvatore	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5 & 6</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22 drawn to multi-ply absorbent article classified in class 442, subclass, 59 +.
 - II. Claims 23-34, drawn method for using multi-ply absorbent article, classified in class, 604 subclass, 360.
2. The inventions are distinct, each from the other because:

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the method of using can be practiced with a materially different product such as an absorbent article comprising a single layer or an absorbent article without siloxane.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert Carpenter on August 27, 2002 a provisional election was made without traverse to prosecute the invention of multi-ply absorbent article claims 1-22. Affirmation of this election must be made by applicant in replying to this Office

Art Unit: 1771

action. Claims 23-34 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1-3 and 5-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., US 4,738,847 in view of Goulet et al., WO 99/37860.

The patent issued to Rothe et al., discloses a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract). Preferably the absorbent article comprises three plies, wherein the inner or middle layer further comprises a virucidally effective amount of a virucidal composition (Column 1, lines 22-35). Rothe et al., teaches applying the virucidal composition to the inner ply layer to reduce any irritation that may

Art Unit: 1771

result from having the virucidal composition present on the surface of the article (Column 2, lines 10-20). The plies may be made from webs of cellulosic creped wadding, however, non-woven webs synthetic polymeric fibers are also suitable (Column 2, lines 47-54). The three-ply absorbent article is suitable for use as facial tissues, bathroom tissues, paper towels or wipes (Column 1, lines 36-39). Suitable virucidal compositions include acids having the formula $R-COOH$, wherein R is selected from the group of lower alkyl; substituted lower alkyl; carboxy lower alkyl or carboxy dihydroxy (Column 1, lines 40-60).

Rothe et al., fails to teach applying a siloxane compound to at least a portion of said outer plies, however, the PCT application to Goulet et al., discloses applying an amine-modified polysiloxane to the outer surfaces of a three-ply tissue product. The general formula of the amine-modified polysiloxane is that of the Applicant's structure in claim 9 (Page 4, line 10) wherein, R_1-R_9 moieties can be C_1 or greater alkyl substituents. R_2-R_5 can be hydroxy or C_1 , or greater alkyl alcohol substituents. R_{10} can include any amine-related functional groups (Page 4, lines 14-18). To balance the hydrophobicity Goulet et al., teaches blending a modified polysiloxane having the Applicant's structure depicted in claim 11, with the amine-modified polysiloxane (Page 4, lines 22-25), wherein x and y are integers > than 0. The mole ratio of x to (x + y) can be from .005% to about 25%. R_1-R_9 moieties can be C_1 or greater alkyl substituents. R_2-R_5 can be hydroxy or C_1 , or greater alkyl alcohol substituents. R_{11} can include functional groups such as ether, polyether, ester, amine, imine, amide as well as alkyl and alkenyl analogues (Page 5, lines 1-6). For example R_{11} can be a polyether functional group of the generic form $R_{12}-(R_{13}-O)_a-(R_{14}-O)_b-R_{15}$; wherein R_{12} , R_{13} and R_{14} are alkyl chains of C_1 or greater, R_{15} can be hydrogen or C_1-C_4 alkyl group and "a" and "b" can be integers from 1-100 (Page 5, lines 1-10).

Art Unit: 1771

Goulet et al., teaches the amine-modified polysiloxane to the surfaces of the tissue product to impart softness and a degree of hydrophobicity to prevent wet through of liquids during use.

With regard to claims 15-19, the prior art happens to teach several of the claimed final products such as tissues, paper towels, and wipes, however, these use limitations recited in the claim are not given patentable weight at this time since the prior art *meets* the structural and chemical limitations. In other words, as recited, any multi-ply absorbent article having the claimed property limitations could function in the desired capacity since there are no *other* structural and/or chemical distinguishing features used to define the facial tissue, bath tissue, paper towel, diaper, or sanitary napkin.

Therefore, motivated to impart softness and a degree of hydrophobicity to a virucidal multi-ply absorbent article it would have been obvious to having ordinary skill in the art at the time the invention was made to apply the amine-modified polysiloxane composition of Goulet et al., to the multi-ply virucidal absorbent article of Rothe et al.

9. Claims 1-8,13,14,18,19,20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., (as discussed above), in view of Roe et al., US 5,635,191.

Recall that the patent issued to Rothe et al., teaches a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract), however, Rothe et al., fails to teach applying a siloxane composition to the outer ply surfaces. The patent issued to Roe et al., discloses a disposable diaper comprising a liquid pervious top sheet having a fluid polysiloxane emollient/ lotion applied to the surface thereof (Abstract). The diaper construction generally includes the polysiloxane containing top sheet, an absorbent core, and a liquid impervious back sheet (Column 4, lines 18-24). Roe et al., discloses that the

Art Unit: 1771

absorbent capacity of the core may be tailored suit a variety personal care needs such as diapers, sanitary napkins and incontinence pads (Column 5, lines 1-5). Suitable polysiloxane compounds include phenyl-functional polymethylsiloxane compounds. Roe et al. also teaches that effective substitution of the phenyl or alkyl functional groups may be made with amino, carboxyl, or hydroxyl groups (Column 12, lines 29-45). Therefore, motivated by the desire to produce a virucidal disposable personal care article it would have been obvious to one having ordinary skill in the art to treat the absorbent inner core of the Roe et al. invention with the virucidal composition of Rothe et al.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2002/0001726 A1
US 4,790, 836
US 5,196,244

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Application/Control Number: 09/753,134

Page 7

Art Unit: 1771

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September 28, 2002


CHERYL A. JUSKA
PRIMARY EXAMINER